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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055081
Party	Plaintiff Academy of Motion Picture Arts and Sciences
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Attachments	92055081- Petitioner Resp to Improper Motion for Board Participation.pdf (4 pages)(55090 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 3,974,726
Registered June 7, 2011
Mark: OSCAR

ACADEMY OF MOTION PICTURE ARTS AND
SCIENCES,

Petitioner,

-against-

ALLIANCE OF PROFESSIONALS AND
CONSULTANTS, INC.,

Respondent.

Cancellation No. 92055081

**RESPONSE TO RESPONDENT'S
IMPROPERLY SUBMITTED MOTION
FOR BOARD PARTICIPATION IN
DISCOVERY CONFERENCE**

Petitioner Academy of Motion Picture Arts and Sciences ("Petitioner") submits this response to RESPONDENT'S MOTION TO REQUEST PARTICIPATION BY A BOARD INTERLOCUTORY ATTORNEY OR ADMINISTRATIVE TRADEMARK JUDGE IN DISCOVERY CONFERENCE, and respectfully requests that the Trademark Trial and Appeal Board (the "Board") deny said motion as deficient and filed in disregard of the procedure established by the Board for submitting such requests.

As the Trademark Trial and Appeal Board Manual of Procedure (TBMP) makes clear:

If any party wants a Board professional to participate in the required discovery conference, the party **must** call the Board attorney assigned to the case or file such request through ESTTA (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, no later than ten (10) days prior to the deadline for conducting the discovery conference, so as to facilitate completion of the conference by the deadline.

Trademark Trial and Appeal Board Manual of Procedure, 3d ed. 2012 §401.01 (emphasis added). This mandate is echoed in the cover sheet that was mailed to the parties at the inception of this matter:

The request for Board participation **must** be made through the Electronic System for Trademark Trials and Appeals (ESTTA) or by telephone call to the interlocutory attorney assigned to the case, whose name can be found by referencing the TTABVUE record for this case at <http://ttabvue.uspto.gov/ttabvue/>.

TTAB Cover Notice for Cancellation No. 92055081, January 24, 2012 (Baez, Vionette) ("Cover Notice") (emphasis added). Further, "The parties should contact the assigned interlocutory attorney or file a request for Board participation through ESTTA **only after the parties have agreed on possible dates and times for their conference.**" Id. (emphasis added).

Respondent did not utilize the efficient ESTTA process mandated by TBMP §401.01 that would have ensured that this issue be settled before the November 27, 2012 discovery conference deadline established by the Board. Instead, Respondent couched its request as a motion, which it then filed by hard copy with the Board and served on Petitioner by mail (without even a courtesy copy via e-mail), which, in turn, triggered a twenty-day response period that now threatens to undermine the Board's discovery schedule. Also, Respondent has provided no evidence, nor is any apparent, that Respondent contacted the Board attorney assigned to this case by telephone – another option provided by the Board. TBMP §401.01; Cover Notice. Finally, Respondent certainly did not follow the Board's mandate and wait until "the parties have agreed on possible dates and times for their conference" before submitting its motion. Cover Notice.

Because Respondent disregarded the Board's instructions and filed a motion that is procedurally deficient, the Board is urged to disregard Respondent's request for Board participation in the discovery conference.

Substantively, there is no need for Board participation in what should be a routine trademark-infringement/unfair competition discovery process. We note that, while the Board's September 27th decision dismissed Petitioner's dilution claim, this does not alter the nature of the relevant discovery. Fact or expert disclosures related to Lanham Act Section 2(a) and 2(d) issues in this proceeding are substantively no different from those related to the dilution claim. Petitioner's counsel looks forward to

the discovery conference and is, under separate cover, making efforts to schedule the conference for a time convenient to both parties.

Accordingly, Petitioner respectfully requests that Respondent's Motion be denied and that the schedule set out by the TTAB, including the November 27 discovery conference deadline, be enforced.

Respectfully submitted,

Dated: New York, New York
November 22, 2012

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CERTIFICATE OF SERVICE

I certify that on the 22nd day of November, 2012, I caused a true copy of the attached PETITIONER'S RESPONSE TO RESPONDENT'S IMPROPERLY SUBMITTED MOTION FOR BOARD PARTICIPATION IN DISCOVERY CONFERENCE to be served on Respondent Alliance of Professionals & Consultants, Inc., by sending same via U.S. Mail to:

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